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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/524,762

02/15/2005

Werner Bonrath

DSM-05-US

3414

50446

7590

03/19/2009

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MILLBURN, NJ 07041

EXAMINER

GALE, KELLETTE

ART UNIT

PAPER NUMBER

1621

MAIL DATE

DELIVERY MODE

03/19/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|---------------------------------------|--|
| Office Action Summary | Application No. 10/524,762 | Applicant(s) BONRATH ET AL. | |
| | Examiner KELLETT GALE | Art Unit 1621 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

Claims 1-31 are pending in this application.

Claims 1-31 are rejected in this office action.

Request for Continued Prosecution

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6 January 2009 has been entered.

Declaration

In applicant's remarks, there was mention of a second declaration. It is noted herein that no second declaration was found to be of record therefore, no second declaration was considered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-31 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Tedeschi et al (US 3,709,946) in view of Wolfe et al (US 3,383,427).

Applicant claims a process for the manufacture of an acetylenically unsaturated alcohol comprising reacting a carbonyl compound with acetylene in the presence of ammonia and an alkali metal hydroxide.

Determination of the scope and content of the prior art

(MPEP §2141.01)

Tedeschi et al teaches a process for preparing an acetylenic alcohol by reacting a ketone with liquefied acetylene in the presence of a co-catalyst system comprising liquid ammonia and an alkali metal hydroxide.

Wolfe et al teaches a process for preparing acetylenic alcohol using aqueous alkali metal hydroxide (col. 1, lines 39-50 and example I).

Ascertainment of the difference between the prior art and the claims

(MPEP §2141.02)

Tedeschi et al do not teach the specific ketone. Tedeschi et al teaches powdered alkali metal hydroxide. Also, process parameters may not be exactly the same in Tedeschi et al as that which is claimed.

**Finding of prima facie obviousness Rational and
Motivation (MPEP §2142-2143)**

Since Tedeschi et al teaches that any ketone can be used in his process of preparing an acetylenic alcohol; it would be obvious for one having ordinary skill in the art at the time of the instant invention to prepare such an alcohol using any ketone and expect to arrive at the desired acetylenic alcohol. One having ordinary skill in the art at the time of the instant invention would be motivated to do so as Tedeschi et al has recited successful results in his examples. Also, since Wolfe et al teaches that aqueous alkali metal hydroxide can be used in the process for preparing an acetylenic alcohol, it would be obvious for one having ordinary skill in the art at the time of the instant invention to utilize this teaching in the process taught by Tedeschi. One having ordinary skill in the art at the time of the instant invention would be motivated to use an aqueous alkali metal hydroxide in the process taught by Tedeschi as it is known in the art that reactants react better in solution.

Also, merely modifying the process conditions such as temperature and concentration is not a patentable modification absent a showing of criticality. In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

Arguments

Applicant's arguments filed January 6, 2009 have been fully considered but they are not persuasive. Applicant argues that the Tedeschi et al reference teaches

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examples in the high end of the range of 1:1000 to 1:2. There is no teaching or suggestion to use the lower ratio. Also, there is no showing that the powdered alkali metal hydroxide become aqueous as there is no water present in the reaction.

Response to Arguments

As far as the powdered alkali metal hydroxide goes, this has been addressed in this office action under 103 rejections. Also, although there is no specific example that uses the ratio of alkali metal hydroxide to the carbonyl compound in the lower range, It is taught that it can be used and this is enough motivation for one having ordinary skill in the art at the time of the instant invention to want to use the ratio at the lower end of the range.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KELLETTE GALE whose telephone number is (571)272-8038. The examiner can normally be reached on M-F (6:30am-3:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, DANIEL SULLIVAN can be reached on 571-272-0779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Kellette Gale
Patent Examiner
Technology Center 1600

March 12, 2009

/Daniel M Sullivan/
Supervisory Patent Examiner, Art Unit 1621